



AUG 6 2001

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(C)  
:

**MEMORANDUM AND ORDER**

petitions for regrading his answers to questions 3, 8, 11, 17, 26 and 50 of the morning section and question 13 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 66. On January 4, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of the Office of Patent Legal Administration.

### **OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers. The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the answer which refers to each and every one of the correct choices. Where a question includes a

answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions. Where the terms "USPTO" or "Office" are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for morning question 50. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning questions 3, 8, 11, 17 and 26 and afternoon question 13. Petitioner's arguments for these questions are addressed individually below.

Morning question 3 reads as follows:

3. You are a registered practitioner and filed a new application on behalf of John. All claims were drawn to a single invention. With the application, you submitted an offer to elect without traverse if the Office deems the application to be drawn to more than one invention, a search made by a foreign patent office, one copy each of the references deemed most closely related to the claimed subject matter, and a detailed discussion of the references pointing out with the particularity required by 37 C.F.R. § 1.111(b) and (c), how the claimed subject matter is patentable over the references. You also submitted a petition to make John's application special. John was 75 years of age at the time of filing, and in such poor health that his doctor had issued a certificate stating that John is unable to assist in the prosecution of his application. Which of the following, singularly or in combination, submitted with the petition, is not sufficient to result in the petition being granted?

I. The fee set forth in 37 C.F.R. § 1.17(I).

II. John's birth certificate showing his date of birth.

III. The doctor's certificate stating that John's health is such that he is unable to assist in the prosecution of his application.

(A) I

(B) II

(C) III

(D) II and III

(E) None of the above.

The model answer is selection E.

MPEP § 708.02. I is sufficient to result in the petition being granted. MPEP § 708.02, subpart (VIII). II is sufficient. MPEP § 708.02, subpart (IV). III is sufficient. MPEP § 708.02, subpart (III). Therefore, (A) through (D) are incorrect.

Petitioner argues that answer (A) is correct. Petitioner contends that the fee set forth in 37 CFR §1.17 (i) is not sufficient to result in the petition being granted. Petitioner argues that specific "grounds" are required in all circumstances set out in 37 CFR §1.102 in order to warrant making special an application.

Petitioner's arguments have been fully considered but are not persuasive. MPEP 708.02 (VIII)(Special Examining procedure for Certain New Application Accelerated Examination), states as follows:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

(A) Submits a petition to make special accompanied by the fee set forth in 37 CFR §1.17(I):

(B) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status. . . . . If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

Contrary to petitioner's statement that applicant must assert specific "grounds" for petition special status, 37 CFR 1.102 requires a showing to justify advancement. MPEP 708.02 (VIII) clearly states that the petition for special status will proceed with paying the general process fee if the provisions of that section are complied with, which constitutes sufficient showing to meet the requirement of 37 CFR 1.102. Accordingly, model answer (E) is correct and Petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 8 reads as follows:

8. Which of the following is true?

(A) If after the filing of a reissue application no errors in the original patent are found, a reissue patent will be granted on the reissue application noting no change, and the original patent will be returned to the applicant.

(B) In order to add matter not previously found in the patent, a continuation-in-part reissue application must be filed.

(C) In a reissue application, additions and deletions to the original patent should be made by underlining and bracketing, respectively, except for changes made in prior Certificates of Correction and disclaimer(s) of claims under 37 C.F.R. §1.321(a).

(D) A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.

(E) (A), (B), and (C).

The model answer is selection C.

See MPEP § 1411.01. As to (A) see MPEP § 1402. A reissue patent is not granted. As to (B), new matter may not be entered in a reissue. As to (D) see MPEP § 1412.03, p.1400-13. Since (A), and (B) are incorrect, (E) is incorrect.

Petitioner argues that answer (D) is correct and model answer (C) is incorrect. Petitioner contends that answer (C) was written to suggest changes were made “in” the prior Certificates of Correction and disclaimer(s), constituting further changes in those Certificates of Correction and disclaimer(s) such that they could no longer be treated as reflective of the original patent materials. Petitioner also argues that answer (D) made no mention of any reservation for future broadening, and without this expressed reservation, a dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.

Petitioner’s arguments have been fully considered but are not persuasive. There is no need to assume that further certificate of correction changes are made contemporaneously with the reissue application. Absent such an assumption, there is no distinction between the prepositions “in” and “by”. As indicated in the exam instructions, “Do not assume any additional facts not presented in the questions.” Citing MPEP §1411.01, Petitioner admitted that the changes of Certificates of Correction and disclaimer(s) should be made without using underling or brackets. As to Petitioner’s argument that answer (D) is the best choice because no “reservation “ ground has been expressed in this question, answer (D) states that “A dependent claim may be broadened in a reissue application only in the first two years of the enforceable life of the patent.” A dependent claim, however broadened, will not broaden the scope of the patent, and therefore may be introduced over two years following the issue of the patent. Answer (D) is inconsistent with MPEP §1412.03 (pp. 1400-13). Accordingly, model answer (C) is correct and petitioner’s answer (D) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 11 reads as follows:

11. An Office action issued with a three month shortened statutory period for reply. Four and one-half months after the mailing date of the Office action, the applicant submitted a fully responsive amendment along with a petition and fee for a one-month extension of time. The petition for extension of time included an authorization to charge fees under 37 C.F.R. § 1.17 to applicant’s deposit account. The applicant knew at the time the amendment was filed that a two-month extension of time was required. Unfortunately,

however, a clerical error was made that resulted in only a one-month extension of time being requested. Applicant overlooked this error when the amendment was filed.

Assuming no further papers by applicant, which of the following statements is true?

- (A) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unavoidable.
- (B) The amendment is treated as untimely and the application becomes abandoned. However, applicant may petition to revive the abandoned application on the basis that the abandonment was unintentional.
- (C) The petition for a one-month extension of time will be construed as a petition requesting the appropriate period of extension, and the appropriate fee will be charged to the deposit account.
- (D) Applicant will be notified that the petition for extension of time was insufficient and will be given 30 days from the mailing date of the notification to request an extension of time for a second month.
- (E) None of the above.

The model answer is selection C.

37 C.F.R. § 1.136; MPEP § 710.02(e), p. 700-77. (A) and (B) are not true because the amendment is treated as timely. There is no authority for (D). (E) is untrue because (C) is true.

Petitioner argues that answer (B) is correct. Petitioner contends that because the expressly authorized fee was insufficient, the application becomes abandoned. However, since the error was unintentional, the applicant can petition to revive application in accordance with 37 CFR 1.137(b). Petitioner further argues that answer (C) is incorrect answer because the factual pattern in this question does not reveal any express and conflicting direction pursuant to 37 CFR 1.136(a)(3), which is a safety net rule to prevent potential loss of patent rights by creating a constructive petition. As a result, the contract law should prevail in governing this scenario, e.g. one-month extension only, not two-month.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the applicant had no need of the "safety net" provisions of 37 CFR 1.136(a)(3) for omitted, previously filed, or constructively needed petition, the exam instructions stress the importance of not assuming any additional facts

not pertinent to the question. MPEP §710.02(e) gives an substantially identical example in accordance with the practice of PTO:

For example, if a petition (and requisite fee) for a two-month extension of time containing an authorization to charge fee deficiencies to a deposit account are filed in an application four and one-half months after the date a notice of appeal was filed in that application, it is Office practice to treat the petition as requesting the period of extension (three months) necessary to make the petition filed within the extended period for reply. This practice applies even if no further reply (appeal brief or continued prosecution application (CPA) under 37 CFR 1.53(d) ) is filed in the application to be treated as a constructive petition for an extension of time under 37 CFR 1.136(a)(3). (pp.700-77)

Although Petitioner argues on the merits of contract law, nevertheless exam instruction specifically states that “The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette.” Therefore, answer (C) is the best answer. Accordingly, petitioner’s answer (B) is incorrect.

No error in grading has been shown. Petitioner’s request for credit on this question is denied.

Morning question 17 reads as follows:

17. In June 1997, Rene invents a circuit board device which automatically logs a computer onto the Internet without the need for entering passwords. During the prosecution of the patent for the circuit board device, Rene’s patent practitioner files the following claims 1 and 2:

1. An electronic device for automatically logging onto the Internet comprising: communication means for communicating on the Internet, said communication means further comprising circuit means for automatically entering a password, and storage means for automatically storing a password for logging onto the Internet.
2. The device of claim 1 wherein the communication means is a desktop computer.



During the patent prosecution, the examiner cites as prior art a telephone with a memory, which automatically dials a telephone number. The examiner reasons that because the telephone can store the number in its memory, it would have been obvious to store a password in the memory as well. The examiner objects to claim 2 as being dependent upon a rejected claim. Being very eager to get patent protection and low on financial resources, Rene instructs the practitioner to combine claims one and two and allow the application to issue. One year and one day after issuance, Rene comes to you, a patent attorney, inquiring if her patent reads on a widely distributed, hand-held, pocket sized, portable device that is not a telephone and does not use a desktop computer to access the Internet automatically without a password, and if not, what corrective action is available. Which of the following choices is the best advice for Rene?

- (A) Since the two-year period for broadening has not expired, Rene may file a reissue with a declaration stating that the failure to claim more was due to error without deceptive intent. Rene may broaden her claims to the extent permitted by the prior art, since at no time did she narrow her claims to avoid the prior art.
- (B) Since the prior art device was a telephone, Rene is entitled to seek patent protection on all that which is not in the prior art. Rene should be able to obtain broadened patent protection by reissue of the patent.
- (C) Since Rene's original claim 1 was broadly written and since Rene narrowed her scope of patent protection by incorporating the limitations of the original claim 2 during the original prosecution, she is barred by the doctrine of recapture from enlarging her claims to the scope of the original claim 1.
- (D) Although Rene narrowed her claims during the original prosecution, she can file a declaration stating that the narrowing of her claims was not because she believed the prior art precluded her from claiming more but due to financial concerns. Therefore, the narrowing of the claim was error without deceptive intent and Rene may file a reissue seeking broader claims.
- (E) Rene should file a request for reexamination seeking to enlarge the scope of her patent protection.

The model answer is selection C.

Rene is barred by the recapture rule. MPEP § 1412.02. As to (A), see MPEP § 1412.02. Rene responded to a rejection by amending her claims, similar to Example B in MPEP § 1412.02, p.1400-10. As to (B), again recapture is the determinative factor. As to (D), the issue of financial concerns is of no import. As to (E) independent claims may not be broadened during a reexamination.

Petitioner argues that either answer (A) or (B) is the best choice because each seeks to provide Rene what she seeks in light of the absence of any facts detracting from her ability to obtain what she seeks. Petitioner contends that model (C) is not correct because recapture doctrine does not apply to Rene's reissue application. Petitioner points out that the "widely distributed, hand-held, pocket sized, portable device is not a telephone and does not use a desktop computer to access the Internet automatically without a password." Accordingly, petitioner argues, Rene's reissue claims would appear not to be germane to the related prior rejection, therefore recapture rule should not bar the claim and answer (C), although admitted to be true, is not the best advice because of irrelevance and is incorrect.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that this question has no factual indication that Rene's questioned device requires any "aspect germane to a prior art rejection," that is not at issue. At issue is whether selection (C) is the best advice. Petitioner admits that (C) is true. Selections (A) and (B) are both false and therefore cannot be better advice than (C). Selection (A) states Rene may broaden her claims to the extent permitted by the prior art, since at no time did she narrow her claims to avoid the prior art. This is untrue because being very eager to get patent protection and low on financial resources, Rene instructs the practitioner to combine claims one and two and allow the application to issue rather than argue patentability over the art applied by the examiner. Selection (B) states Rene is entitled to seek patent protection on all that which is not in the prior art. This is untrue because Rene may not recapture subject matter surrendered during the prosecution. Subject matter from claim 1 was more broad than the cited prior art, but all of the subject matter surrendered by canceling claim 1 is barred from recapture. Petitioner admits that neither selections (D) nor (E) are the best advice and therefore, selection (C) is necessarily the best advice.

*Clement* held that the guidance as to the nature of "broadening claim" should be determined by whether the broader aspects of the reissue claims relate to surrendered subject matter. See MPEP § 1412.02 (pp.1400-9). In compliance with the instruction, one needs to look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. *Id.* During patent prosecution, Rene has surrendered the original subject matter, it must be presumed that the revised claim limitation was added to obviate the rejection. The subsequent deletion of (omission of) limitation in the reissue claims would be presumed to be a broadening in an aspect of the reissue claims related to surrendered subject matter. See Example (B) in MPEP §1412.02 (pp. 1400-10). Because Rene has narrowed her claim during prosecution, she is barred by the doctrine of recapture to enlarge the scope of the claim by removing the original limitation incorporated in the issued patent. Accordingly, model answer (C) is correct and petitioner's answer (A) or (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Morning question 26 reads as follows:

26. In a reissue patent application, which of the following statements is correct?

- (A) It is unnecessary to claim the benefit of an earlier filing date in a foreign country in order to gain the benefits of 35 U.S.C. § 119(a)-(d) so long as such a claim was made in the application on which the original patent was granted.
- (B) New matter, that is, matter not present in the patent sought to be reissued, may be included in a reissue application in accordance with 35 U.S.C. § 251.
- (C) No additional certified copy of the foreign application is necessary if a claim for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) is made in a reissue application as well as in the application on which the original patent was granted.
- (D) The recapture rule permits a patentee to acquire through reissue claims that are, in all respects, of the same scope as, or are broader than, those claims canceled from the original application to obtain a patent.
- (E) A practitioner's failure to appreciate the full scope of the invention is not an error correctable through reissue.

The model answer is selection C.

MPEP § 1417. The procedure is similar to that for "Continuing Applications" in MPEP § 201.14(b). (A) is incorrect. MPEP § 1417. A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. § 119(a)-(d) must be made in a reissue application even though such a claim was made in the application on which the original patent was granted. (B) is incorrect. New matter is excluded from a reissue application in accordance with 35 U.S.C. 251. Also see MPEP § 1411.02. (D) is incorrect. MPEP § 1412.02, "Reissue Claims Have Same Or Broader Scope In All Respects." The recapture rule bars a patentee from acquiring through reissue claims that are, in all respects, of the same scope as, or are broader than, those claims canceled from the original application to obtain a patent. *Ball Corp v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). (E) is incorrect. A practitioner's failure to

appreciate the full scope of the invention has been held to be an error correctable through reissue. In re Wilder, 736 F.2d 1516, 222 USPQ 369 (Fed. Cir. 1984); MPEP § 1402

Petitioner argues that model (C) is incorrect. Petitioner contends that the second half of answer (C), which requires no submission of a certified copy of the foreign application for claiming an earlier filing date on the original application is a false statement. Petitioner further argues that all answers had varying degrees of incorrectness, therefore this question should designate "all answers accepted."

Petitioner's arguments have been fully considered but are not persuasive. Selection (C) states that when a claim for priority is made in a reissue application as well as in the application on which the original patent was granted, no certified copy is needed for the reissue application, which is correct. Contrary to petitioner's statement that answer (C) is incorrect because the certified copy is required in filing the original application, this argument is not relevant because selection (C) does not suggest otherwise. Petitioner admits the incorrectness of all other answers including petitioner's own answer. Accordingly, model answer (C) is correct and petitioner's request for "all answers accepted" is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 13 reads as follows:

13. On February 3, 1999, you filed an application for inventor Sam, fully disclosing and claiming only the following:

Claim 1. A system for preventing unauthorized entry into a garage, comprising: an electric garage opener coupled to a computer and to a video camera.

You received a non-final Office action dated February 4, 2000, wherein the examiner rejected claim 1 under 35 U.S.C. § 102(b) as anticipated by Dan. The examiner attached a copy of Dan's journal article published on July 4, 1997, fully disclosing an electric garage opener coupled to a computer and to a video camera. Which of the following actions, if taken by you, can overcome the rejection in accordance with proper USPTO practice and procedure?

(A) Timely filing a reply traversing the rejection, arguing that claim 1 is patentably distinguished from the Dan reference.

(B) Timely filing a reply traversing the rejection, arguing that since the date of the Dan reference falls on a Federal holiday, the Dan reference is not a statutory bar under 35 U.S.C. § 102(b).

(C) Timely filing a reply with an affidavit under 37 C.F.R. § 1.131 showing prior invention by Sam.

(D) Timely filing a reply traversing the rejection, arguing that the examiner did not demonstrate why one of ordinary skill in the art at the time the invention was made would have been motivated to modify the system disclosed by Dan.

(E) Timely filing a reply including an amendment to the specification perfecting priority under 35 U.S.C. § 120, containing a specific reference in accordance with 37 C.F.R. § 1.78(a), to a U.S. application filed by Sam on July 3, 1997 that fully disclosed but did not claim a garage opener coupled to a computer and a video camera.

The model answer is selection E.

MPEP § 706.02(b). (A) is incorrect because the Dan reference includes all the elements of claim 1. (B) is incorrect because the Federal holiday is merely to move the statutory bar date to the next succeeding business day. *Ex parte Olah*, 131 USPQ 41 (Bd. App. 1960). (C) is incorrect because a 37 C.F.R. § 1.131 affidavit can not be used to overcome a rejection under 35 U.S.C. § 102(b). (D) is incorrect because the rejection was not made under 35 U.S.C. § 103.

Petitioner argues that answer (A) is correct. Petitioner contends that simply because Sam's and Dan's parts "comprising" their claims appear the same, does not preclude the system being patentable for a different use. Petitioner argues that Sam can assert a new "use" for his patent in distinguishing the Dan's publication under 35 U.S.C. § 102 (b). Therefore, Petitioner concludes, answer (A) is the best answer.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that asserting a different "use" can overcome the § 102(b) rejection, MPEP § 706.02(b)(A) states that applicant must persuasively argue that the claims are patentably distinguishable from the prior art. Sam's claim is not on the novel use of the system. Sam's claim recites a system comprising an electric garage opener coupled to a computer and a video camera. It has been shown that Sam's claim is fully anticipated by Dan's publication. Selection (A) precludes amending the claim as suggested by petitioner to become a method claim; selection (A) specifies timely filing a reply traversing the rejection, not accepting and amending, and arguing that claim 1 is patentably distinguished from the Dan reference. Accordingly, model answer (E) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 67. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'Robert J. Spar', is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy